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March 7, 2005

(Date)

Docket AVERP2850US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF APPEALS**

In re application of Hannington

Group Art Unit: 1771

Serial No: 09/742,654

Examiner: V. Chang

Filed: December 21, 2000

For: ADHESIVE ARTICLES WITH IMPROVED AIR EGRESS

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**APPLICANTS' BRIEF ON APPEAL**

Dear Sir:

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**Appendix: Claims on Appeal**

**I. REAL PARTY IN INTEREST**

The real party in interest is Avery Dennison Corporation, 150 North Orange Grove Boulevard, Pasadena, California 91103, the assignee of the above-captioned application.

**II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the instant appeal.

**III. STATUS OF CLAIMS**

Claims 27-29 and 32-52 are pending in the application. Claims 27-29 and 32-52 are rejected. Claim 28 has been objected to. Claims 1-26, 30-31 and 53-95 have been cancelled. The claims are reproduced in the attached APPENDIX.

This is an appeal from the final Office Action of October 5, 2004 rejecting claims 27-29 and 32-52 in the above-identified application.

**IV. STATUS OF AMENDMENTS**

An amendment under 37 C.F.R. 1.116 was filed on December 3, 2004 amending the title and the abstract, but providing no claim amendments. An Advisory Action was issued on December 28, 2004 stating that the proposed were not entered.

**V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

The present invention is directed to adhesive articles that are useful for making industrial graphics and large adhesive backed films, including decorative films with improved air egress (page 2, paragraph 0008, page 3, paragraph 0019). The adhesive article comprises a continuous layer of adhesive having a lower surface into which is embedded a pattern of non-adhesive material forms; and a facestock having a front surface and a back surface, with the back surface adhered to the upper surface of the adhesive (page 2, paragraph 0008). A release layer may be adhered to the lower surface of the adhesive layer (page 3, paragraph 0020 and Figs. 1b, 2b and 5b).

The non-adhesive material forms may be embedded into the adhesive layer so that the bottom surfaces of the non-adhesive material forms are above the plane of the lower surface of the adhesive layer (page 16, paragraph 0054, Figs. 4a and 4b).

In one embodiment, a second adhesive layer is adhered to the upper surface of the facestock. Non-adhesive material forms may also be embedded into the upper surface of the second adhesive layer so that the top surfaces of the non-adhesive material forms are even with or below the plane of the upper surface of the second adhesive layer (page 19, paragraph 0062).

The non-adhesive material forms may comprise a UV curable ink (page 8, paragraph 0036). The non-adhesive material forms may also be presented in a pattern of dots, lines or any geometric figure (page 8, paragraph 0035).

In one embodiment of the invention, the adhesive layer has a textured surface (page 14, paragraph 0051, Fig. 2a). The release liner may also have a textured surface complementary to the textured surface of the adhesive layer (page 14, paragraph 0051, Fig. 2b).

The non-adhesive material forms embedded into the adhesive layer maintain channels in the adhesive (page 16, paragraph 0054). Upon application of the exposed adhesive to a surface using pressure, the channels collapse or partially collapse, which allows trapped air to move to the exposed edges (page 16, paragraph 0054).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

- A. Claim 28 has been objected to on the grounds that it specifies a range of about 30 nanometers to about 100 nanometers.
- B. Claim 28 stand rejected under 35 U.S.C. §112, first paragraph, on the grounds that the specification does not reasonably provide enablement for a thin coating of 0.03  $\mu$ .
- C. Claims 27-29 and 32-52 stand rejected under 35 U.S.C. §112, first paragraph, as being based on a disclosure that is not enabling.

## **VII. ARGUMENT**

- A. Claim 28 specifies a range that is consistent with the disclosure in the specification.

The Examiner's Rejection:

The Examiner has objected to claim 28 on the grounds that it specifies a range that is inconsistent with the teachings in the specification. The Examiner states that the specification expressly teaches a thickness from about  $0.3\mu$  (300 nanometers) to about  $100\mu$  (specification, paragraph 0031), wherein claim 28 specifies 30 nanometers to about  $100\mu$ .

Applicant's Response and Remarks:

Applicant respectfully submits that there is no basis for the Examiner's conclusion that claim 28 specifies a range that is inconsistent with the teachings in the specification. Paragraph [0038] of the specification (page 9) supports claim 28. Paragraph [0038] states:

"In one embodiment, the non-adhesive layer is a printing ink having a thickness from about 0.3 to about 100 microns, from about 0.5 to about 50 microns, or from about 2 to about 20 microns. The non-adhesive material may also be applied to the pressure sensitive adhesive by means of patterned vacuum metallization or sputtering. In this embodiment, the non-adhesive layer typically has a thickness from about 30 to about 3000, from about 100 to about 2000, or from about 300 to about 1500 nanometers."

Paragraph [0038] clearly discloses that the non-adhesive material forms may have thicknesses as low as about 30 nanometers and as high as about 100 microns. Thus, claim 28, which specifies that the non-adhesive material forms have an average thickness of about 30 nanometers to about 100 microns, is clearly supported by paragraph [0038].

Because claim 28 is clearly supported by and is consistent with the disclosure of the specification, the objection should be withdrawn.

B. Claim 28 is based on a disclosure that is enabling.

The Examiner's Rejection:

The Examiner has maintained that the specification, while being enabling for the thickness of non-adhesive material forms having an average thickness of from about  $0.3\mu$  to about  $100\mu$ , or from  $0.5\mu$  to  $50\mu$ , or from about  $2\mu$  to about  $20\mu$ , does not reasonable provide enablement for a thin coating of  $0.03\mu$  (30 nanometers). The Examiner

contends that the specification does not enable any person skilled in the art to which it pertains to make and/or use the invention commensurate in scope with the extremely thin layer of non-adhesive material form. The Examiner also contends that the original specification clearly leads one of ordinary skill in the art to a much thicker and narrower range ( $2\mu$  to about  $20\mu$ , paragraph 0035).

The Examiner has relied, in part, on the periodic table, stating that the diameter of a carbon atom is  $1.82\text{\AA}$ , so that a thickness of 30 nanometers is only approximately equivalent to 182 carbon atoms stacked in a straight line side-by-side. The Examiner contends that the non-adhesive material forms typically contain thousands of carbon atoms in each polymer molecule, therefore it is unreasonable to disclose a thickness of 30 nanometers for the cured non-adhesive material forms. Thus, it is the Examiner's position that the Applicant is required to provide proper evidentiary support that an extremely thin coating of only 30 nanometers is reasonably enabled for the intended use of the instant invention.

Applicant's Response and Remarks:

Applicant respectfully submits that there is no basis for the Examiner's conclusion that the specification does not reasonably provide enablement for a thin coating of  $0.03\mu$  (30 nanometers). Paragraph [0038] of the specification supports claim 28. Paragraph [0038] states that the non-adhesive material forms having thicknesses as low as 30 nanometers can be applied "by means of patterned vacuum metallization or sputtering." Applicant respectfully submits that this constitutes an enabling disclosure for the non-adhesive material forms having thicknesses as low as 30 nanometers.

Furthermore, the Examiner relies only on the periodic table in stating that the diameter of a carbon atom is  $1.82\text{\AA}$ , so a thickness of 30 nanometers is only approximately equivalent to 182 carbon atoms stacked in a straight line side-by-side. The Examiner also states that a thickness of 30 nanometers is unreasonable, since the non-adhesive material forms would typically contain thousands of carbon atoms in each polymer molecule. In support of the Examiner's reliance on the foregoing statements as fact, the Examiner must provide more evidence than mere citation to the Periodic Table. The Examiner must provide a citation to prior art or an affidavit supporting the foregoing statements or withdraw the statements.

The Examiner has the burden to establish a reasonable basis to question the enablement provided for a claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (Examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure).

When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993), *citing In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971).

The Examiner has failed to meet this burden. Because no reasonable statement of fact or prior art reference has been supplied to doubt the teachings in the Applicant's specification, the disclosure of patterned sputtering and vacuum metallization provided in the Applicant's specification must be regarded as sufficient to comply with the enablement requirement of 35 USC §112. Accordingly, the Examiner's rejection of claim 28 under 35 USC §112, first paragraph, should be reversed.

C. Claims 27-29 and 32-52 are based on a disclosure that is enabling.

#### The Examiner's Rejection

The Examiner has maintained that a pattern of non-adhesive material providing a path for air egress from adhesive article is critical or essential to the practice of the invention. The Examiner contends that the instantly claimed invention is directed to "an adhesive article which provides air egress" by a non-adhesive material which is generally present in a pattern that provides a path for air egress from the adhesive article, such as when lines are used, at least about 50% of the pattern should extend to the edge of the adhesive article to obtain acceptable air egress (specification, paragraph 0031). The Examiner also contends that these aforementioned essential elements are absent from independent claim 27, and renders the claimed invention not enabled by the disclosure.

The Examiner contends that the adhesive articles are directed to various distinct inventions. It is the Examiner's position that previously canceled claims 53-95 are directed to adhesive articles having repositionability and slidability, whereas claims 27-29 and 32-52 of the instant invention are directed to adhesive articles having air egress only.

Applicant's Response and Remarks

Applicant respectfully submits that there is no basis for the Examiner's contention. In paragraph [0008], the Applicant's specification states (emphasis added):

[0008] This invention relates to an adhesive article which provides air egress. Air egress is provided by supplying at least one route, such as areas of no initial adhesion for the air to flow out from under the construction. The invention relates to an adhesive article comprising a facestock having a front surface and a back surface, a continuous layer of adhesive having an upper surface and a lower surface, wherein the upper surface of the adhesive layer is adhered to the back surface of the facestock, and a pattern of non-adhesive material forms that are in embedded into the lower or upper surface of the adhesive layer. The invention further relates to methods of preparing the adhesive articles. These articles have usefulness as industrial graphics images, as well as decorative coverings, etc. The articles provide one or more of air egress, repositionability and slideability.

This is consistent with paragraph [0019] which states: "The adhesive articles provide one or more of air egress, repositionability and slidability for easy application to a substrate." Air egress is one of several features provided by the Applicant's claimed adhesive articles. Air egress is neither critical nor essential. The "one or more of" phrase used in paragraphs [0008] and [0019] may be satisfied by the exclusion of air egress, making air egress not only not critical, but unnecessary.

Applicant thus respectfully submits that the characterization of air egress by the Examiner as "critical or essential" is contrary to the teachings in the Applicant's specification. The statements in the specification that the adhesive articles provide one or more of air egress, repositionability and slideability are sufficient to rebut the argument of criticality. "In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Broad language in the disclosure (including the abstract) omitting an allegedly critical feature tends to rebut the argument of criticality." *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 432 (CCPA 1976), citing *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). Further, limiting an applicant to the preferred materials would

not serve the constitutional purpose of promoting the progress in the useful arts. Features that are merely preferred are not to be considered critical. *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 432 (CCPA 1976), citing *In re Armbruster*, 512 F.2d 676, 185 USPQ 152 (CCPA 1975).


The Examiner's comments concerning "canceled claims 53-95" are not relevant to the question of whether claims 27-29 and 32-52 are enabled. Applicant respectfully submits that 35 U.S.C. §112, first paragraph, requires nothing more than objective enablement. Whether this is achieved by use of illustrative examples or broad terminology is of no importance. As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. §112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

Applicant respectfully submits that an enabling disclosure is provided in the present specification that is sufficient to support claims 27-29 and 32-52 and, thus, the claims need not be narrowed. The rejection of claims 27-29 and 32-52 under 35 USC §112, first paragraph, should be reversed.

For the foregoing reasons, Appellant respectfully submits that the claimed invention is based on a disclosure that is fully enabling. This honorable Board is requested to reverse the Examiner's rejections of all of the claims pending in the application and to allow these claims.

Respectfully submitted,

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APPENDIX

Claims 1-26 (Canceled)

27. An adhesive article comprising:

a facestock having a front surface and a back surface;

a continuous layer of adhesive having an upper surface and a lower surface and end edges, wherein the upper surface of the adhesive is adhered to the back surface of the facestock; and

a pattern of non-adhesive material forms embedded into the lower surface of the adhesive layer, each of said non-adhesive material forms having a bottom surface, wherein the bottom surfaces of the non-adhesive material forms are above the plane of the lower surface of the adhesive layer.

28. The adhesive article of claim 27 wherein the non-adhesive material forms have an average thickness of about 30 nanometers to about 100  $\mu$ .

29. The adhesive article of claim 27 wherein the non-adhesive material comprises a UV curable ink.

Claims 30-31. (canceled)

32. The adhesive article of claim 27 wherein the pattern of non-adhesive material forms comprises a plurality of dots, lines or combinations thereof.

33. The adhesive article of claim 32 wherein the lines of non-adhesive material have an average width of from about 12  $\mu$  to about 250  $\mu$  and an average thickness of from about 30 nanometers to about 100  $\mu$ .

34. The adhesive article of claim 33 wherein at least 50% of the lines intersect the end edges of the adhesive layer.

35. The adhesive article of claim 33 wherein a plurality of lines form a grid pattern.

36. The adhesive article of claim 27 wherein the adhesive layer comprises a pressure sensitive adhesive.

37. The adhesive article of claim 27 wherein the adhesive layer comprises a heat-activated adhesive.

38. The adhesive article of claim 27 wherein the non-adhesive material comprises a porous non-adhesive material.

39. The adhesive article of claim 38 wherein the porous non-adhesive material comprises an elastomer.

40. The adhesive article of claim 27 wherein the article is wound so that the patterned lower surface of the adhesive is in adhesive contact with the front surface of the facestock.

41. The adhesive article of claim 40 wherein the front surface of the facestock has a release coating.

42. The adhesive article of claim 27 further comprising a release liner having a release surface, wherein said release surface is adhered to the lower surface of the adhesive layer.

43. The adhesive article of claim 42 wherein the release surface of the release liner has a textured surface.

44. The adhesive article of claim 43 wherein the release surface has a random texture.

45. The adhesive article of claim 43 wherein the release surface has a patterned finish.

46. The adhesive article of claim 44 wherein the lower surface of the adhesive layer has a textured surface that is complementary to the textured surface of the release liner.

47. The adhesive article of claim 42 wherein the release surface of the release liner has randomly distributed non-adhesive particulate material thereon.

48. The adhesive article of claim 47 wherein the randomly distributed non-adhesive particulate material is at least partially embedded into the release surface.

49. The adhesive article of claim 42 wherein the release surface of the release liner has a non-adhesive material printed thereon.

50. The adhesive article of claim 49 wherein the non-adhesive material printed on the release surface of the release liner is embedded into the release surface.

51. The adhesive article of claim 27 further comprising a second adhesive layer having an upper and lower surface, wherein the lower surface of the second adhesive is adhered to the front surface of the facestock.

52. The adhesive article of claim 51 wherein a pattern of non-adhesive material forms is embedded into the upper surface of the second adhesive layer, each of said non-adhesive material forms having a top surface, wherein the top surfaces of the non-adhesive material forms are even with or below the plane of the upper surface of the second adhesive layer.

Claims 53-95 (Cancelled)